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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/799,738

03/15/2004

Paul Nicolas Muret

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08/31/2006

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EXAMINER

LU, KUEN S

ART UNIT

PAPER NUMBER

2167

DATE MAILED: 08/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/799,738

Applicant(s)

MURET ET AL.

Examiner

Kuen S. Lu

Art Unit

2167

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/15/2004</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. The Action is responsive to Applicant's Application filed March 15, 2004. Claims 1-14 are pending.

#### ***Information Disclosure Statement***

2. Information Disclosure Statements filed March 15, 2004 is considered and corresponding PTO-1449 is electronically signed and attached.

#### ***Drawings***

3. The drawings, filed March 15, 2004 are considered in compliance with 37 CFR 1.81 and accepted.

#### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. § 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

##### **4.1. As set forth in MPEP 2106 (II) (A):**

The claimed invention as a whole must accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." State Street, 149 F.3d at 1373, 47 USPQ2d at 1601-02. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of "real world" value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (Brenner v. Manson, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96); In re Ziegler, 992, F.2d 1197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 1993)). Accordingly, a complete disclosure should contain some indication of the practical application for the claimed invention, i.e., why the applicant believes the claimed invention is useful.

Apart from the utility requirement of 35 U.S.C. 101, usefulness under the patent eligibility standard requires significant functionality to be present to satisfy the useful result aspect of the practical application requirement. See Arrhythmia, 958 F.2d at 1057, 22 USPQ2d at 1036. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make the invention eligible for patenting. For example, a claim directed to a word processing file stored on a disk may satisfy the utility requirement of 35 U.S.C. 101 since the information stored may have some "real world" value. However, the mere fact that the claim may satisfy the utility requirement of 35 U.S.C. 101 does not mean that a useful result is achieved under the practical application requirement. The claimed invention as a whole must produce a "useful, concrete and tangible" result to have a practical application.

4.2. Claims 11-14 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

As per claims 11 and 13, the claimed invention represents a computer usable medium having computer code embodied therein for creating and delivering reports, respectively. It is noted "computer usable medium" comprises wireless telecommunication signals and carrier waves, forms of energy. As forms of energy, the signals and waves are not a matter, composition of matter or product; and do not fall within any one of categories of patentable subject matter. The medium is not computer readable storage and will not produce **tangible** result. However, a tangible, concrete and useful result is required in a practical application test. The consequence is non-statutory. For further rejecting the claim under 35 USC §102 or 35 USC §103, Examiner interprets "computer usable medium" as "computer readable storage medium"

As per claims 12 and 14, which inherit and do not remedy the deficiency of practical application requirements of independent claims 11 and 13, respectively, and are likewise, non-statutory.

#### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office action:

5.1. A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by

another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**5.2.** Claims 1-14 are rejected under 35 U.S.C. 102(e) as anticipated by Salas et al. (U.S. Patent 6,233,600, hereafter "Salas").

As per claim 1, Salas teaches "A method of delivering reports to a client over a distributed network" (See col. 1, line 66 – col. 2, line 11 where a networked and collaborative system allow users to share work and files, including web browsing, downloading and uploading files), comprising:

"sending code for creating reports to the client over the distributed network, in response to a first report request from the client" (See col. 2, lines 39-45 where file request from client workstation is received by the server and HTTP is utilized for file transmission); "sending report data to the client over the distributed network, in response to report selections made by the client, if the client does not already have the report data" (See col. 2, lines 19-27 where project data is downloaded to the client workstation); and "creating a report using the report data and the code" (See col. 2, lines 19-27 where project data and template file is rendered for generating HTML page).

As per claim 6, Salas teaches "A method of creating reports at a client side using report data sent over a distributed network" (See col. 1, line 66 – col. 2, line 11 where a networked and collaborative system allow users to share work and files, including web browsing, creating new web pages, downloading and uploading files), comprising:

“receiving code for creating reports from a server over the distributed network” (See col. 2, lines 39-45 where file request from client workstation is received by the server and HTTP is utilized for file transmission);

“receiving report data from the server over the distributed network if the report data is not already present at the client side” (See col. 2, lines 19-27 where project data is downloaded to the client workstation); and

“creating a report using the report data and the code” (See col. 2, lines 19-27 where project data and template file is rendered for generating HTML page).

As per claims 2 and 7, Salas further teaches “the client comprises a web browser” (See col. 2, lines 4-11 where user interact with web browser to upload and download files between client workstation and server).

As per claims 3 and 8, Salas further teaches “the code for creating reports comprises Javascript code” (See Fig. 4 and col. 5, lines 54-59 where eRoom Page includes Javascript elements).

As per claims 4 and 9, Salas further teaches “for subsequent report requests from the client, corresponding report data is sent to the client, if the client does not already have the corresponding report data, and a corresponding report is created by the code using the corresponding report data” (See col. 3, lines 44-48 and col. 4, line 66 – col. 5, line 6

where client makes plural data requests and data received by client workstation is utilized with corresponding template files for rendering object specific eRoom page).

As per claims 5 and 10, Salas further teaches "the code, when executed by the client, creates a navigation frame and a report frame" (See Fig. 4 and col. 5, lines 21-53 where eRoom page is an HTML page including frames for containing navigation bar and reports such as Staff plan and Announcements).

As per claim 11, Salas teaches "An article of manufacture" (See Figs. 1 and 3, col. 3, lines 15-23 and col. 4, lines 4-22 where a system of servers, network and workstations having corresponding applications is an article of manufacturing), comprising:  
"a computer usable medium having computer readable program code embodied therein for creating reports at a client side using report data sent over a distributed network, the computer readable program code in the article of manufacture" (See Figs. 1 and 3 and col. 2, lines 1-18 where system and method including servers, network, workstations and executable software are integrated for users to perform collaborative project tasks, such as browsing web pages, participating project, and creating, downloading and uploading files) comprising:  
"computer readable program code for receiving, from a server over a distributed network, computer readable code for creating reports" (See col. 2, lines 39-45 where file request executed by application and made from client workstation is received by the server and HTTP is utilized for file transmission); and

"computer readable program code for receiving report data from the server over the distributed network, if the report data is not already present at the client side" (See col. 2, lines 19-27 and 39-45 where file request executed by application and made from client workstation is received by the server, HTTP protocol is utilized for file or data transmission and project data is downloaded to the client workstation);

"wherein the computer readable program code for creating reports creates the reports based on the received report data" (See col. 2, lines 19-27 and 39-45 where file request executed by application and made from client workstation is received by the server, HTTP protocol is utilized for file transmission, project data is downloaded to the client workstation and project data and template file is rendered for generating HTML page).

As per claim 13, Salas teaches "An article of manufacture, comprising: a computer usable medium having computer readable program code embodied therein for delivering reports to a client over a distributed network, the computer readable program code in the article of manufacture" (See Figs. 1 and 3, col. 3, lines 15-23 and col. 4, lines 4-22 where a system of servers, network and workstations having corresponding applications is an article of manufacturing and further at Figs. 1 and 3 and col. 2, lines 1-18 where system and method including servers, network, workstations and executable software are integrated for users to perform collaborative project tasks, such as browsing web pages, participating project, and creating, downloading and uploading files) comprising:



"computer readable program code for creating reports" (See col. 2, lines 19-27 and 39-45 where application is executed for utilizing project data and template file renders generating HTML page);

"computer readable program code for sending the computer readable code for creating reports to the client over the distributed network, in response to a first report request from the client" (See col. 2, lines 19-27 and 39-45 where file request executed by application and made from client workstation is received by the server, HTTP protocol is utilized for file transmission, project data is downloaded to the client workstation and project data and template file is utilized rendering the generation of HTML page); and  
"computer readable program code for sending report data to the client over the distributed network, in response to report selections made by the client, if the client does not already have the report data" (See col. 2, lines 19-27 and 39-45 where file request executed by application and made from client workstation is received by the server, HTTP protocol is utilized for file or data transmission and project data is downloaded to the client workstation).

As per claims 12 and 14, Salas further teaches "the computer readable program code for creating reports comprises Javascript" (See Fig. 4 and col. 5, lines 54-59 where eRoom Page includes Java script elements).

### ***Conclusion***

#### **6. The prior art made of record**

A. U.S. Patent No. 6,233,600

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

B. U.S. Patent No. 6,377,993

C. U.S. Patent No. 6,691,259

D. U.S. Patent No. 6,768,994

E. U.S. Patent No. 6,701,323

F. U.S. Patent No. 6,789,115

***Contact Information***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuen S Lu whose telephone number is (571) 272-4114. The examiner can normally be reached on Monday-Friday (8:00 am-5:00 pm). If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Cottingham can be reached on (571) 272-7079. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for Page 13 published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 886-217-9197 (toll-free).

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Kuen S. Lu



Patent Examiner, Art Unit 2167

August 29, 2006